

REMARKS

The Examiner's action dated January 6, 2009, has been received, and its contents carefully noted.

RENEWED REQUEST TO CONSIDER PREVIOUSLY ELECTED CLAIMS

IT IS NOTED THAT CLAIMS 3-6 CONTINUE TO BE WITHDRAWN FROM CONSIDERATION. HOWEVER, THE ORIGINAL ELECTION OF SPECIES REQUIREMENT IDENTIFIED THE ELECTED GROUP III, AS CONTAINING CLAIMS 1-2 AND 5-14. IT WOULD APPEAR THAT, IN VIEW OF THE REASON GIVING FOR THE ELECTION REQUIREMENT, CLAIMS 5 AND 6 SHOULD PROPERLY HAVE BEEN CONSIDERED TO BE INCLUDED WITHIN THE ELECTED GROUP. UNDERSIGNED DOES NOT BELIEVE THAT THE EXAMINER CAN IGNORE CLAIMS INCLUDED IN AN ELECTED GROUP WITHOUT ISSUING A NEW RESTRICTION REQUIREMENT.

IT IS POSSIBLE THAT, AT THE TIME THE ELECTION WAS MADE, APPLICANTS CONSIDERED CLAIMS 5 AND 6 TO BE OF PARTICULAR IMPORTANCE AND APPLICANT HAD EVERY REASON TO BELIEVE THAT, BASED ON EXISTING PTO RULES, THOSE CLAIMS WOULD BE EXAMINED.

THEREFORE, APPLICANTS ARE ENTITLED TO A FIRST ACTION ON THE MERITS ON CLAIMS 5 AND 6.

In order to advance matters, application claim 1 has been amended to more clearly define the contribution of the invention over the prior art and the prior art rejection is traversed at least for the reason that the novel structure now defined in the claims, and particularly in parent claim 1, is not disclosed in or suggested by any combination of the teachings of the applied references.

Independent claim 1 stands rejected under 35 U.S.C 103(a) as being unpatentable over Clarey '713 (hereinafter *Clarey*) in view of Dye. The applicants respectfully traverse this rejection, and submit that claim 1 contains at least three limitations that are not taught or suggested by the cited patents.

Claim 1 contains a limitation that the inflatable portion of the splint is "structured to cover the body part from three sides, leaving one side uncovered" (emphasis added). Neither Clarey nor Dye teaches or suggests this limitation.

Clarey teaches an inflatable splint that covers the body part from all of its sides (see, for instance, Fig. 2). Thus, it is simply incorrect to assert that this reference discloses a splint that covers a body part from only three sides. Moreover, the purpose of Clarey's invention is to fully encase an injured leg with an air-pressure splint. Thus,

modifying Clarey to meet the above claim limitation would be contrary to the teachings of that reference because it would make the modified splint non-satisfactory for its intended use.

Claim 1, as previously presented, defined "a non-inflatable portion comprising at least one adjustable member for connecting said two opposed edges together". In the explanation of the previous rejection of claim 1, the "adjustable" feature appears to have been ignored. To clarify this important feature, claim 1 has now been further amended to specify that the adjustable member connects the opposed edges together "in a manner to allow adjustment of the pressure and tightness of said splint on the body part". Support for this recitation will be found at page 5, lines 12-14 of the specification.

It is absolutely clear that one feature of the Clarey splint is that its connecting element, which appears to be a type of zipper, does not allow for any adjustment.

The applicants submit that the above-cited limitation is not taught or suggested by Clarey (or Dye), and that modifying the Clarey splint to include the above-cited limitation would make that splint non-suitable for its intended purpose. The applicants respectfully submit that

even if only because of these reasons, amended claim 1 is patentable over the cited art.

It is noted that Dye was relied on only for its disclosure of ventilation holes. This element has been deleted from application claim 1 because it is not believed necessary to distinguish over the prior art. This notwithstanding, the present rejection of claim 1 continues to be based in part on Dye. Nevertheless, since claim 1 does not recite ventilation holes, it is clear that only the applicability of the Clarey patent to amended claim 1 need be considered.

Furthermore, claim 1 contains a limitation that the splint comprises "at least one gas pressure source device connected to said splint". The Examiner stated that Clarey discloses this limitation in that the tubes can be inflated orally (page 2 of the Office Action, penultimate line). The applicants respectfully traverse.

The applicants respectfully submit that oral inflation is not a teaching or a suggestion to have a gas pressure source as a component of the splint. The splint taught by Clarey does not comprise the mouth or lungs of the person that inflates the tubes orally, and accordingly, Clarey does not teach a splint comprising a gas pressure source

device. A human being cannot be considered to correspond to a claimed structural component.

In addition, the office action did not even suggest any rationale for modifying Clarey to include a gas pressure source as a component of the splint.

Thus, the applicants respectfully submit that even for this reason alone, the Office Action did not present a *prima facie* case of obviousness against claim 1.

Still further, claim 1 contains a limitation that when the inflatable tubes are inflated, the splint "fits the structure of the body part". The applicants respectfully submit that Clarey does not teach or suggest a splint that fits the structure of the body part.

To summarize, the applicants submit that claim 1 contains at least three limitations not taught or suggested by the cited references, and that in view of these differences between the claim and the cited patents, the claim is patentable.

All the other claims depend, directly or indirectly, from claim 1, and are therefore patentable at least by virtue of being dependent from an allowable base claim.

Since the claims that have been withdrawn from consideration depend from claim 1, and claim 1 is believed to define patentably over the applied references, it would be

appropriate to withdraw the election of species requirement, and allow all of the pending claims, and it is requested that this be done.

Claim 21 further distinguishes over the prior, as represented by the applied references, by its recitation of "comprising ventilation holes for skin ventilation contained in, and extending through, the non-inflatable parts". This is the one feature for which the rejection placed reliance on the Dye patent. However this feature is not disclosed in that reference.

With regard to this feature the examiner appears to rely on the disclosure in Dye of holes 44. However, the explanation of the rejection does not appear to take any account of the fact that the holes 44 of Dye are provided only in inflatable parts of the compression sleeve. Thus, while pressurized air is being supplied to the inflatable parts of the compression sleeve, it is continually escaping through holes 44, with the result that the patient is tethered to the pressurized air source.

The ventilation holes in a splint according to the present invention are in non-inflatable parts of the splint, so that they do not affect the air pressure in the inflatable parts and allow a circulation of air between the area outside the splint and the patient's skin.

It follows that one cannot reasonably equate holes 44 of Dye to the claimed ventilation holes.

In view of the foregoing, it is again requested that the present rejection be reconsidered and withdrawn and that all of the pending claims be allowed.

Undersigned recently contacted the examiner to arrange an interview, but this interview could not be held before filing of this response. Counsel will contact the examiner shortly to determine whether an interview is needed to place the application in condition for allowance.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By /jmf/
Jay M. Finkelstein
Registration No. 21,082

JMF:smb
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528